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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,639	11/24/2000	Richard Hans Harvey	063170.6601	3833
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BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER PANNALA, SATHYANARAYA R	
			ART UNIT 2164	PAPER NUMBER
			NOTIFICATION DATE 01/29/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/721,639

Applicant(s)

HARVEY, RICHARD HANS

Examiner

Sathyanarayan Pannala

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 11, 12 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11, 12 and 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2007 has been entered.

Response to Amendment

2. Applicant's Amendment filed on 10/31/2007 has been entered with amended claims 1, 11 and newly added claims 17-22 and it is in response to the Office Action mailed on 9/10/2007. In this Office Action claims 1-5, 11-12 and 15-22 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 11 and 17-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1 and 11 are phrased as "preventing the amended information entry from being searchable until at least the 'in' table includes the amended information entry" is not supported by the specification. Applicant cited as page 5, lines 17-31 and states as "According to the present application, when an add entry operation is performed, information is added to the entry table first, that is to the 'out' table, such that the information is not visible initially." Applicant is misinterpreting the specification and thorough grasping of the cited reference is required.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 11 and 17-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, page 2, lines 9-10, claiming as "preventing the amended information entry from being searchable until at least the 'in' table includes the amended information entry" whereas the specification silent about it. Similarly claim 11, is claiming. More clarification is needed.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-5, 11-12 and 15-22 are rejected under 35 U.S.C. § 101, because none of the claims are directed to statutory subject matter. Independent claim 1 deals with simple abstract idea of determining whether an instruction or operation and the steps of these claims are non-patentable. Claim 11 and the steps of these claims are non-patentable as they are software per se. A claim that recites a computer that solely calculates a mathematical formula or a computer disk that solely stores a mathematical formula is not directed to the type of statutory subject matter eligible for patent protection. The claims are not producing useful, concrete and tangible results. See *Diehr*, 450 U.S. at 186 and *Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972). In *Sarkar*, 588 F.2d at 1335, 200 USPQ at 139, See recent court case, *In-Re Comiskey*, _____, Fed. Cir., 2007 _____ decided 9/20/2007. (see MPEP 2106(IV)(B)(2)(b)(ii)).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-5 and 11-12 and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bachmann et al. (US Patent 6,085,188) hereinafter Bachmann, and in view of Byrne et al. (US Patent 6,347,312) hereinafter Byrne.

11. Bachmann teaches independent claims 1, 11 by the following: determining whether an instruction or operation adds an information entry or removes information entry from a database system, wherein for an add operation, the information entry is first added to an 'out' table, and wherein for a remove operation, the information entry is first removed from an 'in' table (Fig. 7-8, col. 6, line 47 to col. 7, line 15). Bachmann teaches the parent table and child table, which is analogous to using two tables of in and out and explicitly does not teach the in and out tables. However, Byrne teaches two tables which are similar to the purpose of in and out tables as Type I cache (40) and Type II cache (42). Type I is for a set of identifiers which qualify for a given LDAP search query of a particular filter key and the unit is indexed by that filter key. This way the repetitive search queries are handled without resort to the relational database (38). A record for Type one is the same as the in table. Whereas Type II cache maintains results of the query (Byrne, Fig. 5, col. 5, line 50 to col. 6, lines 11). The search is done

first and the data is filled into Type II and then search query in Type I one will be retained. When the search query did not find the record, the query will not be retained in the Type I and the result will not be available to store in the Type II. Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to combine teaching of the cited references because Byrne's teachings would have allowed Bachmann's method would have been efficient of handling of repetitive searches issued from a hierarchical directory service to a relational database backing store (Byrne, col. 2, lines 22-25).

Bachmann teaches the claimed, employing the instruction or operation to amend the information entry in the database system (Fig. 8, col. 6, lines 60-64).

Additionally, Examiner has experience in using Sybase database system. Sybase database uses out-table and in-table. These tables are system tables and every database system uses similar system tables. In case of Sybase, these tables could be accessed or seen by the system user. An application controlling the process creates a record in out-table and the system monitors the presence of records. The system disposes of the records in the in-table as they are acted upon as well as from out-table. When the system non-invasively monitors processes, an external application such as the application controlling the process disposes of the records as they are acted upon.

Bachmann teaches the claimed, preventing the amended information entry from being searchable until at least the 'in' table includes the amended information entry (Fig. 7-8, col. 6, line 47 to col. 7, line 15).

12. As per dependent claim 2, Bachmann teaches "the information is added to the 'in' table after being added to the 'out' table" (Fig. 8, col. 6, line 60 to col. 7, line 15).

13. As per dependent claim 3, Bachmann teaches "the information is removed from the 'out' table after being removed from the 'in' table" (Fig. 7, col. 6, lines 47-59).

14. As per dependent claim 4, Bachmann teaches "performing one entry operation of the plurality of add and remove entry operations if the instruction or operation is determining whether the instruction modify entry information" (Fig. 8, col. 5, lines 60-67, col. 6, lines 60-67).

15. As per dependent claims 5, 12, Bachmann teaches claimed "the instructions are implemented via a directory system such as X.500 or LDAP" (Fig. 4A-C, col. 4, lines 22-35).

16. As per dependent claims 15, 16 Bachmann teaches the claimed "using the out table to retrieve a result of the search of the in table." (Fig. 8, col. 6, line 60 to col. 7, line 15).

17. As per dependent claims 17-18, Bachmann teaches the claimed, preventing the amended information entry from being searchable until at least the 'in' table includes the amended information entry comprises always preventing the amended information entry

from being searchable until at least the 'in' table includes the amended information entry (Fig. 7-8, col. 6, line 47 to col. 7, line 15).

18. As per dependent claims 19-20, Bachmann teaches the claimed, only the amended information entry is prevented from being searchable until at least the 'in' table includes the amended information entry (Fig. 7-8, col. 6, line 47 to col. 7, line 15).

19. As per dependent claims 21-22, Bachmann teaches the claimed, preventing the amended information entry from being searchable until at least the 'in' table includes the amended information entry comprises making the amended information entry non-visible until at least the 'in' table includes the amended information entry (Fig. 7-8, col. 6, line 47 to col. 7, line 15).

Response to Arguments

20. Applicant's arguments filed on 10/31/2007 with respect claims 1-5, 11-12 and 15-22 have been fully considered but they are not persuasive and the details as follows:

a) Applicant's argument regarding claims rejection under 35 U.S.C. § 101, states as "The Examiner rejects Claims 1-5, 11-12, and 15-22 under 35 U.S.C. § 101, stating that none of the claims are directed to statutory subject matter."

In response to Applicant's argument, Examiner respectfully disagrees with the applicant because the method claims 1-5, 15, 17, 19, 21 and the system

claims 11-12, 16, 18, 20, 22 are deals with an abstract idea and rejected under software per se.

b) Applicant's argument regarding claims rejection under 35 U.S.C. § 112, 1st and 2nd paragraphs, states as "Applicant has amended Claims 1 and 11 to remove the element "the 'out' table being non-visible to a search of the 'in' table," rendering these rejections moot. Accordingly, Applicant requests reconsideration and allowance of Claims 1 and 11."

In response to Applicant's argument, Examiner respectfully disagrees with the applicant because Applicant did not grasp thoroughly the cited specification and amended the claims different from the specification.

c) Applicant's argument regarding claims rejection under 35 U.S.C. § 103, states as "neither Bachmann nor Byrne disclose "preventing the amended information entry from being searchable until at least the 'in' table includes the amended information entry" of Claim 1."


In response to Applicant's argument, Examiner respectfully disagrees with the applicant because Bachmann and Byrne combined do teach all limitations of claims 1 and 11 and for details, see under Claims Rejection under 103 section.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sathyanarayan Pannala
Primary Examiner

srp
January 21, 2008